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REMARKS

Applicant's attorney notes with appreciation the indication by the examiner of the allowability of the subject matter recited in original claim 7. Accordingly, that claim has been amended to place it in independent form by including the subject matter of original claims 1 and 5. Claim 5 has been canceled without prejudice or disclaimer.

Claims 1 through 6, 8 through 11, and 13 were rejected under 35 U.S.C. § 103(a) based upon the Wahl et al. '755 and the Hanggi et al. '643 references. The rejection is based upon the conclusion that the Wahl et al. reference discloses the preliminary adjusting value determination step, which is the first step in the method as claimed in claim 1, and also the contact force determination as a function of the preliminary adjusting value, which is only a part of the third step. It was acknowledged that the second step, that of determining a regulator output value, was not disclosed in the Wahl et al. reference. However, in addition to not disclosing the second step, the Wahl et al. reference also does not disclose the entire third step as it is claimed because the reference fails to teach that the contact force is determined from a control variable that is a function of a regulator output value as well as of the preliminary adjusting value. Thus, the Wahl et al. reference does not teach the claimed invention as it is recited in claim 1 and those claims that depend from it.

In addition to its failure to teach the claimed invention, the Wahl et al. reference is directed to a different physical structure – a multi-disk clutch –

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and it also is directed to the use of a rotating ring of hydraulic fluid to provide a rotational pressure. Those structural and functional differences would lead one having only ordinary skill in the art away from that disclosure as having any reasonable applicability to the problem and to the invention that is disclosed and claimed in the present application.

The Hanggi et al. reference was cited in the Office Action as disclosing the determination of a regulator output value and the determination of a contact force from the regulator output value. However, it is significant that the Hanggi et al. reference does not disclose the determination of a contact force from a control variable that is a function of the regulator output value as well as of the preliminary adjusting value, as claimed in claim 1. Additionally, as was the case with the Wahl et al. reference, the Hanggi et al. reference is directed to a different problem -- the provision in a transmission having a desired speed ratio. And one of only ordinary skill in the art seeking a solution to a contact force adjustment problem would not be led to a disclosure that relates to a speed ratio problem.

Clearly, neither of the Wahl et al. nor the Hanggi et al. references, by themselves, teach or suggest the invention as it is claimed in claim 1. But those references also do not contain any hint or suggestion that would motivate one having only ordinary skill in the art to combine them as the examiner has done. As noted above, each of the references relied upon by the examiner relates to a different structural arrangement, to a different problem, and to a

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different method than those to which the present invention is directed. And because of those differences, there would be no motivation to combine them.

It is important to note that the references do not contain any teaching or suggestion as to precisely how they could be combined to arrive at the invention as claimed. In that regard, it is not apparent from the references which features of which reference are to be combined with which features of the other reference. In short, the references do not contain any hints concerning how they could or should be combined, assuming one even wished to attempt to do so. Accordingly, the only motivation for combining the references in the manner the examiner has done is the disclosure of the present application. But it is an improper basis for rejection to use as a road map or as a template an inventor's disclosure to aid in picking and choosing particular parts of particular references that allegedly can be combined to render obvious that which only the inventor has taught. Thus, the invention as claimed in claim 1 is directed to an invention that is not obvious from the teachings of the references relied upon.

Although one could assert broadly, as the examiner has done, that there exists a motivation to make a combination of particular references in a particular way, such a mere broad assertion is insufficient. In that regard, it has been held that for there to be a sufficient showing of a motivation to combine the teachings of references, that motivation must be supported by referring to some relevant and identifiable source of information. Conclusory statements of possible advantages that would lead one to combine the teachings of several references, and assumptions of what an ordinarily skilled person would or would

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not do, are by themselves inadequate to support a conclusion that there exists a motivation to combine references in a particular way.

The remaining claims each depend from claim 1, and therefore the same distinctions as are noted above in connection with claim 1 apply with equal effect to the dependent claims. Additionally, the dependent claims contain further recitations that define combinations of method steps that further distinguish over the disclosures of the references relied upon by the examiner.

Claim 12 was rejected under 35 U.S.C. § 103(a) based upon the Wahl et al. '755 and the Hanggi et al. '643 references, as applied to claim 1, and further in view of the Danz et al. '977 reference. However, the Wahl et al. and the Hanggi et al. references have already been distinguished over the invention as it is claimed in claim 1, from which claim 12 depends. Accordingly, the combination of references relied upon does not disclose or suggest the invention as it is claimed in claim 12.

Based upon the foregoing amendments and remarks, the claims as they now stand in the application are believed clearly to be in allowable form in that they patentably distinguish over the disclosures contained in the references that were cited and relied upon by the examiner, whether those references be considered in the context of 35 U.S.C. § 102 or of 35 U.S.C. § 103. Consequently, reconsideration and reexamination of the application is respectfully requested with a view toward the issuance of an early Notice of Allowance.

The examiner is cordially invited to telephone the undersigned attorney if this Amendment raises any questions, so that any such question can be

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quickly resolved in order that the present application can proceed toward allowance.

Respectfully submitted,



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